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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,583	02/10/2004	Toshihiko Takeda	00862.021664.1	9531

5514 7590 09/06/2005

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EXAMINER

CLEVELAND, MICHAEL B

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/774,583	Applicant(s) TAKEDA ET AL.	
	Examiner Michael Cleveland	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-43 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 12-43 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☒ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02102004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Priority***

1. Applicant's letter filed 8/2/2005 regarding foreign priority is noted. Applicant states that the foreign priority documents were provided in the parent application 09/788,411. However, the parent application does not contain the priority documents, and there is no indication in the Table of Contents of the file wrapper that such priority documents were received. The Notices of Allowance mailed during prosecution of the parent application do not clearly resolve the issue. One indicates that copies of the foreign priority documents were received in application PCT/JP99/04835 and another indicates that copies were received from the International Bureau. However, the former statement would not have resolved the issue because receipt of the foreign priority documents by WIPO does not satisfy the criteria of 35 USC 119(a)-(d) and the latter statement is against the policy that in a continuation filed under 35 USC 111(a) (rather than a national stage application filed under 35 USC 371) that Applicant, rather than the International Bureau provides the certified copies of the foreign priority documents (See MPEP 1896.). The Examiner requests that certified copies of the foreign priority documents be filed in the present application to clearly establish that Applicant has fulfilled the requirements of 35 USC 119(a)-(d).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 41-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure that clearly defines whether the steps of temperature control refer to the first voltage-applying step, the second voltage-applying step, or both. Therefore,

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there is not support for the full new limitations of the claims. Applicant has not pointed to support for the new limitations in the specification, and there does not appear to be literal support. If it is Applicant's position that such support appears in the Examples, Applicant is requested to point to the specific first and second applying step and the specific steps of temperature control (or for claims 42 and 43, heating and cooling, respectively).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Multiple rejections based on the same main patent have been grouped together.

5. Claims 12-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-10 and 30 of U.S. Patent No. 6,848,961. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of '961, claim 1, part a, dominates the first four steps of current claim 12, and part d dominates the final step. Even though the claims do not specifically state that the container of '961, claim 1, is removed before sealing the electron source substrate to the image forming substrate, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have done so because it is clear that the container (12) does not form part of the sealed image display apparatus (68) (Compare Figs. 1 and 23.), especially because the image forming apparatus works by emitting electrons from the electron source substrate to strike light-emitting regions on the image forming substrate. Container (12) would have blocked such

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emissions, rendering the product non-functional. Claims 2-10 and 30 teach features of the current dependent claims.

Claims 22-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 30 of U.S. Patent No. 6,848,961 in view of Ikeda '061. '961 is described above, but does not explicitly describe 1) that each device is between a pair of electrodes and connected by X- and Y-wiring lines, 2) introducing a carbon-containing gas, or 3) two setting and applying steps. However, such features are known in the art or producing electron-emitting devices, as described in regard to '061 above. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated those features into the claims of '961 with a reasonable expectation of success to have achieved the conventional layouts and purposes described by '061.

6. Claims 12-17, 19, 22, 24-28, 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13-29 of U.S. Patent No. 6,846,213. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of '213, claim 17 explicitly dominates the all but the fifth step of current claim 12. The feature of the fifth step (removing the vessel) would have been obvious because the vessel would have prevented proper operation of the device if it were not removed, for the reasons discussed above. Claims 14-29 teach further features of the dependent claims

Claims 20-21, 23, 31-39, and 41-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-29 of U.S. Patent No. 6,846,213 in view of Ikeda '061. '213 is described above, but does not explicitly describe 1) that each device is connected by X- and Y-wiring lines, 2) introducing a carbon-containing gas, 3) two setting and applying steps or 4) heating or cooling. However, such features are known in the art or producing electron-emitting devices, as described in regard to '061 above. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated those features into the claims of '213 with a reasonable expectation of success to have achieved the conventional layouts and purposes described by '061.

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Claims 18 and 29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-29 of U.S. Patent No. 6,846,213 for the reasons given above and further in view of Dvorsky '864 for substantially the same reasons discussed above.

Claim 40 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-29 of U.S. Patent No. 6,846,213 in view of Ikeda '061 for the reasons given above and further in view of Dvorsky '864 for substantially the same reasons discussed above.

7. Claims 12-14, 19-25, 30-36, and 41-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/913542 in view of Ikeda '061 because '061 teaches that the features of claims 13-14, 19-25, 30-36, and 41-43 are conventional in the art of manufacturing electron-emitting devices, as discussed at length above. Claim 1 of '542 teaches the first four steps of current claim 12, but does not teach joining the electron source to a image forming faceplate. However, '061 teaches that such joining is convention. Removal of the vessel would have been obvious because its presence would have prevented the operation of the device for the reasons already discussed above.

This is a provisional obviousness-type double patenting rejection.

Claims 15, 17-18, 26, 28-29, 37, and 39-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/913542 in view of Ikeda '061 and Dvorsky '864 because '864 teaches that the conventional features of holding substrates, as discussed at length above.

This is a provisional obviousness-type double patenting rejection.

Claims 15-16, 26-27, and 37-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/913542 in view of Ikeda '061 and Okunuki '552 because '552 teaches that the conventional features of holding substrates, as discussed at length above.

This is a provisional obviousness-type double patenting rejection.

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Response to Arguments

8. Applicant's arguments, see pp. 17-18, filed 7/5/2005, with respect to the rejections under 35 USC 102 and 103 have been fully considered and are persuasive. These rejections have been withdrawn. Applicant's amendments resolve the issues under 35 USC 112, 2nd paragraph. However, the amendments do not appear to find full support in the application as originally filed.

9. Applicant's arguments filed 7/5/2005 have been fully considered but they are not persuasive.

Applicant argues that the claims of Nomura '961, Sato '213, and application '542 each fail to teach removing the vessel prior to joining the electron source to an image forming member. The argument is unconvincing because it does not address the issue that such removal would have been obvious and necessary because such a vessel would have interfered with the proper operation by preventing electrons emitted from the electron source substrate from stimulating the light-emitting material(s) on the image display substrate.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cleveland whose telephone number is (571) 272-1418. The examiner can normally be reached on Monday-Thursday, 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Cleveland
Primary Examiner
Art Unit 1762

3/22/2005